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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,649	10/31/2003	Andrew W. Marsden	20341-72637	3775
23643	7590	03/07/2006	EXAMINER	
BARNES & THORNBURG 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204			ELOSHWAY, NIKI MARINA	
			ART UNIT	PAPER NUMBER
			3727	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,649

Applicant(s)

MARSDEN ET AL.

Examiner

Niki M. Eloshway

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 32-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/26/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-31, drawn to a container, classified in class 220, subclass 839.

II. Claims 32-38, drawn to package, classified in class 206, subclass 499.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as set forth in claim 32 does not require the particulars of the subcombination as claimed because the container does not include the cantilevered member with a living hinge of reduced thickness, stepped increments or a concave tether side edge. The subcombination has separate utility such as container used independently of the package.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Rezek on December 15, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32-38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 recites the limitation "the conical tapering" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3-5, 7, 9, 10, 12, 15-17, 19, 20, 23-26, 30 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Hollenbeck (U.S. 4,394,906). Hollenbeck teaches a container 2 having a lid 6, a cup 4, a hinge 8, a tapered configuration at 16-32 and a securing mechanism at 12. Regarding claim 25, the first end is the rim of the lid, the second end is the rim of the cup and the middle portion is element 8.

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Claim 17 is considered a product by process claim. It has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-9, 12, 15, 17-20 and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bentson (U.S. d412,448) in view of Eisenberg (U.S. 3,841,528). Bentson discloses the claimed invention except for the hinge and lid. Eisenberg teaches that it is known to provide a container with a hinge and lid (see elements 10 and 12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the cup of Bentson with the hinge and lid, as taught by Eisenberg, in order to seal the contents of the cup.

13. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hollenbeck (U.S. 4,394,906) in view of Rakes et al. (U.S. 3,786,982). Hollenbeck discloses the claimed invention except for the recess being on the cup and the flange on the lid. Rakes et al. teaches that it is known to provide a recess on the cup and a flange on the lid (see figure 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the container of Hollenbeck with

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the interlocking elements of Rakes et al., in order to securely fasten the lid to the container using an easily formed snap fastener.

14. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bentson (U.S. d412,448) in view of Eisenberg (U.S. 3,841,528), as applied to claim 1 above, and further in view of Bilson (U.S. 3,490,290). The modified cup of Bentson discloses the claimed invention except for the indicia. Bilson teaches that it is known to provide a measuring cup with indicia (see figures 1 and 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified measuring cup of Bentson with the indicia of Bilson, in order to add the correct amount of contents to the cup.

15. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bentson (U.S. d412,448) in view of Eisenberg (U.S. 3,841,528), as applied to claim 1 above, and further in view of Rohlf's (U.S. 6,571,981). The modified cup of Bentson discloses the claimed invention except for the additional containers. Rohlf's teaches that it is known to provide additional containers (see figure 6). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified measuring cup of Bentson with a plurality of additional nested containers, in order to easily store a plurality of cups for multiple uses and users.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is cited for the cup structure.

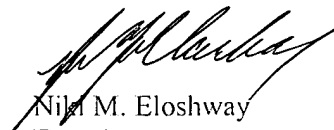
17. THIS ACTION IS NON-FINAL.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niki M. Eloschway whose telephone number is 571-272-4538. The examiner can normally be reached on Thursdays and Fridays 8 a.m. to 4 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Niki M. Eloshway
Examiner
Art Unit 3727

nme